

The opinion in support of the decision being entered today was **not** written for publication in a law journal and is **not** binding precedent of the Board.

Paper No. 22

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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Ex parte WENDI L. NUSBICKEL

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Appeal No. 1998-1434  
Application No. 08/159,647

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ON BRIEF

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Before JERRY SMITH, FLEMING, and BARRY, Administrative Patent Judges.

BARRY, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal under 35 U.S.C. § 134 from the rejection of claims 1-6, 8-15, 17, and 18.<sup>1</sup> We reverse.

BACKGROUND

The invention at issue in this appeal relates to playback of full motion video. Full motion video playback differs from

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<sup>1</sup>Claims 7 and 16, from which claims 8 and 17 respectively depend, were canceled. (Paper No. 6 at 2.)

conventional data transfer (e.g., copying a file, accessing a spreadsheet) in that it requires a sustained high data rate rather than a burst of data. Delivery of data is also time critical; as little as a 0.5 second delay in delivery can result in the reproduced video breaking up. Full motion video playback on a plurality of workstations over a network further complicates data recovery by introducing contention issues.

While redundant arrays of inexpensive disks (RAID) architectures have successfully met conventional data transfer demands for increased bandwidth, the application of RAID to real-time reproduction of independent video segments on a plurality of processors has been less successful. Specifically, conventional RAID architectures fail to recover data quickly enough to meet the real time reproduction demands.

The inventive RAID architecture services workstations making independent requests for reproduction of video segments. Duplicate video segments are stored on each of a plurality of direct access storage devices (DASDs). In

response to a request for a video segment, a single DASD is selected from among the plurality of DASDs, which are listed in a drive information table. The selected DASD retrieves the video segment and the table is updated to reflect use of the DASD. Once the video segment is delivered, the drive information table is updated to reflect freeing of the DASD.

Claim 1, which is representative for our purposes, follows:

1. A method of delivering full motion video on a plurality of playback platforms connected to a single file server over a network, the method comprising:

storing duplicate video segments on each of a plurality of direct access storage devices within a RAID system which is controlled by the single file server;

responsive to a request from a playback platform to the single file server, selecting a direct access storage device for retrieval of the video segment from a drive information table;

instructing the selected direct access storage device to retrieve the video segment;

updating the drive information table to reflect

use of the selected direct access storage  
device for retrieval; and

transmitting the video segment from the selected  
direct access storage device to the  
playback platform over the network.

The references relied on in rejecting the claims follow:

Mincer et al. (Mincer)	5,262,875	Nov. 16,
1993		

Holland et al. (Holland)	5,367,669	Nov.
22, 1994		
	filed Mar 23, 1993.	

Claims 1-6, 8-15, 17, and 18 stand rejected under 35 U.S.C.

§ 103 as obvious over Mincer alone and as obvious over Mincer  
in view of Holland. Rather than repeat the arguments of the  
appellant or examiner in toto, we refer the reader to the  
briefs and answers for the respective details thereof.

OPINION

In reaching our decision in this appeal, we considered the subject matter on appeal and the rejection advanced by the examiner. Furthermore, we duly considered the arguments and evidence of the appellant and examiner. After considering the totality of the record, we are persuaded that the examiner erred in rejecting claims 1-6, 8-15, 17, and 18 as obvious over Mincer alone and over Mincer in view of Holland. Accordingly, we reverse.

We begin by noting the following principles from In re Rijckaert, 9 F.3d 1531, 1532, 28 USPQ2d 1955, 1956 (Fed. Cir. 1993).

In rejecting claims under 35 U.S.C. Section 103, the examiner bears the initial burden of presenting a prima facie case of obviousness. In re Oetiker, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992).... "A prima facie case of obviousness is established when the teachings from the prior art itself would appear to have suggested the claimed subject matter to a person of ordinary skill in the art." In re Bell, 991 F.2d 781, 782, 26 USPQ2d 1529, 1531 (Fed. Cir. 1993) (quoting In re Rinehart, 531 F.2d 1048, 1051, 189 USPQ 143, 147 (CCPA 1976)). If the examiner fails to establish a prima facie case, the rejection is improper and will be overturned. In re Fine, 837 F.2d 1071, 1074, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988).

With these principles in mind, we consider the examiner's rejections and the appellant's argument.

Although Mincer does not teach a RAID system, the examiner concludes that it would have been obvious to implement the reference's storage unit 15 as a RAID-1 (mirrored) system "so that the storage unit maintains plural copies of the video segments and so that the playback systems can access different video segments at any time." (Examiner's Answer at 3-5). The appellant argues, "[n]oting [sic] within *Mincer et al.* can be said to show or suggest the provision of duplicate video segments and the transmission of selected video segments from a particular direct access storage device within the RAID system ...." (Appeal Br. at 7-8) She further argues, "the attempted combination of *Holland et al.* with *Mincer et al.* ... would not result in a system such as that set forth expressly within the claims of the present application." (Reply Br. at 4.)

``[T]he main purpose of the examination, to which every application is subjected, is to try to make sure that what each claim defines is patentable. [T]he name of the game is the claim ....'" In re Hiniker Co., 150 F.3d 1362, 1369, 47 USPQ2d 1523, 1529 (Fed. Cir. 1998) (quoting Giles S. Rich, The Extent of the Protection and Interpretation of Claims--American Perspectives, 21 Int'l Rev. Indus. Prop. & Copyright L. 497, 499, 501 (1990)).

Here, claims 1-6, 8, and 9 each specify in pertinent part the following limitations: "storing duplicate video segments on each of a plurality of direct access storage devices within a RAID system ...;" and "selecting a direct access storage device for retrieval of the video segment ...." Similarly, claims 10-

15, 17, and 18 each specify in pertinent part the following limitations: "a RAID system comprising a plurality of direct access storage devices;" and "means ... for selecting a direct access storage device for retrieval of the video segment ...." Accordingly, claims 1-6, 8-15, 17, and 18 each require

selecting a single direct access storage device (DASD) from a plurality of DASDs of a RAID system.

The examiner fails to show a suggestion of the limitations in the prior art. "Obviousness may not be established using hindsight or in view of the teachings or suggestions of the inventor." Para-Ordnance Mfg. v. SGS Importers Int'l, 73 F.3d 1085, 1087, 37 USPQ2d 1237, 1239 (Fed. Cir. 1995)(citing W.L. Gore & Assocs., Inc. v. Garlock, Inc., 721 F.2d 1540, 1551, 1553, 220 USPQ 303, 311, 312-13 (Fed. Cir. 1983)). "The mere fact that the prior art may be modified in the manner suggested by the Examiner does not make the modification obvious unless the prior art suggested the desirability of the modification." In re Fritch, 972 F.2d 1260, 1266, 23 USPQ2d 1780, 1784 (Fed. Cir. 1992) (citing In re Gordon, 733 F.2d 900, 902, 221 USPQ 1125, 1127 (Fed. Cir. 1984)). "It is impermissible to use the claimed

invention as an instruction manual or 'template' to piece together the teachings of the prior art so that the claimed invention is rendered obvious." Id. at 1266, 23 USPQ2d at



1784, (citing In re Gorman, 933 F.2d 982, 987, 18 USPQ2d 1885, 1888 (Fed. Cir. 1991)).

Here, the examiner admits, "Mincer does not expressly teach ... a RAID system," (Examiner's Answer at 3), let alone selecting a single DASD from a plurality of DASDs of a RAID system. For its part, Holland does teach a RAID-1 scheme of "two independent logical drives." Col. 12, ll. 45-46. The scheme, however, does not select one drive. To the contrary, it simultaneously employs all the drives. Specifically, "Reads are then issued to both drives in parallel in order to start a race." Id. at ll. 50-51.

Because Holland teaches that RAID-1 schemes employ all drives in parallel, we are not persuaded that teachings from the prior art would appear to have suggested the claimed limitations of "selecting a direct access storage device for retrieval of the video segment" or "means ... for selecting a direct access storage device for retrieval of the video segment ...."

The examiner impermissibly relies on the appellant's teachings or suggestions. He fails to establish a prima facie case of

obviousness. Therefore, we reverse the rejections of claims 1-6, 8-15, 17, and 18 under 35 U.S.C. § 103 as obvious over Mincer alone and as obvious over Mincer in view of Holland.

CONCLUSION

In summary, the rejections of claims 1-6, 8-15, 17, and 18 under 35 U.S.C. § 103 as obvious over Mincer alone and as obvious over Mincer in view of Holland are reversed.

REVERSED

JERRY SMITH	)	
Administrative Patent Judge	)	
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	)	
	)	BOARD OF PATENT
MICHAEL R. FLEMING	)	APPEALS
Administrative Patent Judge	)	AND
	)	INTERFERENCES
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LANCE LEONARD BARRY	)	
Administrative Patent Judge	)	

LLB/kis  
Andrew J. Dillon

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FELSMAN, BRADLEY, GUNTER  
& DILLON, LLP  
Suite 350, Lakewood on the Park  
7600B North Capital of Texas Highway  
Austin, TX 78731